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In re Application of LOOSMORE et al. :
Application No.: 10/030,313 :
PCT No.: PCT/CA00/00811 :
Int. Filing: 11 July 2000 :
Priority Date: 15 July 1999 : DECISION ON PETITION
Attorney Docket No.: 1038-1212 MIS:jb : UNDER 37 CFR 1.47(a)
For: MULTI-COMPONENT VACCINE TO :
PROTECT AGAINST DISEASE CAUSED :
BY *HAEMOPHILUS INFLUENZAE* AND :
MORAXELLA CATARRHALIS :

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 18 September 2002.

BACKGROUND

On 18 September 2002, applicants, in response to 01 April 2002 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Ken Sasaki on the grounds that the non-signing inventor refused to execute the declaration. The petition included the requisite petition fee, a verified statement of Reza Yacoob, regarding Mr. Sasaki's refusal to sign and a declaration signed by the 37 CFR 1.47(a) applicants, Sheena Loosmore, Yan-Ping Yang, Michel H. Klein, on behalf of Ken Sasaki.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1) and (3) have been submitted and satisfy the requirements of 37 CFR 1.47(a). With regard to Item (4), a declaration and Power of Attorney executed by Sheena Loosmore, Yan-Ping Yang, Michel H. Klein, on behalf of Ken Sasaki, was submitted on 07 May 2002.

With respect to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions. [Emphasis added.]

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Here, Petitioner submitted an affidavit as to Facts under 37 CFR § 1.47(a)(2) executed by Ms. Yacoob, who is a member of the Patents Department of Aventis Pasteur Limited. Ms. Yacoob states that she has "personal knowledge of the facts set forth" in her declaration. In paragraph five (5) of her declaration, Ms. Yacoob states: "On February 14, 2002, I arranged for a complete copy of the specification for this application, including drawings, to be mailed to Ken Sasaki at his last known address, namely, MDS Pharmaceuticals 6850 Goreway Drive, Mississauga, Ontario L4V 1V7, Canada, along with a Declaration and Power of Attorney document, with a request that he execute and return the paper".

It is not clear from Ms. Yacoob's statement that the letter and a copy of the application papers for U.S. application 10/030,313 (specification, including claims, drawings, and declaration) was actually mailed to Mr. Sasaki and received by him. The statement merely indicates that Ms. Yacoob "arranged" for a copy of the declaration and power of attorney along with a copy of the specification and drawings to be mailed to Mr. Sasaki on February 14, 2002 at his last known address and that there was no response from Mr. Sasaki. Further, the 14 February 2002 letter that accompanied the declaration was not submitted as documentary evidence with this petition. Nor was any proof of mailing to or receipt by Mr. Sasaki presented.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. A copy of the letter to Mr. Sasaki was not presented. There is no indication that the letter was actually delivered to Mr. Sasaki. A diligent effort requires more than arranging for the mailing of the declaration and power of attorney, specification and drawings to the last known address of an inventor. Petitioner should attempt to determine if the address of inventor is correct, or if the inventor left a forwarding address or whether the inventor was only temporarily unavailable (for example, on vacation or hospitalized at the time the attempted delivery occurred) as petitioner provided no evidence that this matter was investigated. This is insufficient evidence to conclude that applicant/inventor Ken Sasaki has refused to sign the application

Furthermore, there is no indication that any attempt was made to contact the inventor using the telephone, and the internet. Attempts to contact Mr. Sasaki via telephone, E-mail, his place of employment, etc. should be tried and documented. The steps taken to locate the whereabouts of the nonsigning inventor should be included in a statement of facts. The statement of facts must be signed, where at all possible by a person having firsthand knowledge of the facts, listing the steps taken to locate the whereabouts of the nonsigning inventor.

Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/030,313 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Sasaki's refusal either in writing or by telephone, to sign these documents.

In sum, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


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